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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
DINH, MINH	
ART UNIT	**PAPER NUMBER**
2132	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/483,063	TOH ET AL.	
	Examiner	Art Unit	
	Minh Dinh	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 January 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. This action is in response to the Appeal Brief filed 11/16/2004. Applicant's arguments with respect to the rejections of claims 24-25 under 35 USC 102 and claims 1-23 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, a search update results in a reference used for new grounds of rejection. The delay in citation of the newly discovered prior art is regretted.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohannon et al (6,134,324) in view of Mullor et al (6,411,941).

Regarding claim 1, Bohannon discloses a software delivery system comprising: a digital storage device containing a plurality of software products, said software products each having been assigned a unique identifier (fig. 1, element 126; fig. 3); and a computer system, said computer system having a drive for reading data stored on the digital storage device, a processor, a hard drive (fig. 1), said computer system having

pre-stored before installation of the software products at least one but not all identifiers corresponding to the identifiers of said software products in the hard drive (fig. 1; fig. 5, element 502; col. 14, line 65 – col. 15, line 4); whereby when said digital storage device is read by said drive, the software products having an identifier which corresponds to the at least one identifier stored in the hard drive is loaded onto said computer system (figures 6A-6B). Bohannon does not disclose using a non-volatile memory to store the identifiers. Mullor discloses using a non-volatile memory to store data regarding software usage authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bohannon system to use a non-volatile memory to store the identifiers, which are software usage authorization data, as taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile memory (col. 3, lines 4-9).

Regarding claim 8, Bohannon discloses a software module containing a software product and associated files (fig. 3). Therefore, the software product identifier is also the software module identifier and claim 8 is rejected on the same basis as claim 1.

Regarding claims 2 and 9, Bohannon further discloses that additional identifiers can be written to the hard drive (col. 3, lines 48-53). Mullor further discloses that the non-volatile memory can be updated to include additional records (col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bohannon system such that the non-volatile memory may be updated to include additional identifiers, as taught by Mullor. The motivation for doing so would have been that additional software could be used with the computer system.

Regarding claims 3 and 10, Bohannon does not disclose that the non-volatile memory is read-only memory. Mullor further discloses that the non-volatile memory is read-only memory (col. 1, lines 46-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bohannon system such that the non-volatile memory is read-only memory, as taught by Mullor. The motivation for doing so would have been that data couldn't be removed or modified.

Regarding claims 4 and 11, Bohannon further discloses that the identifier is encrypted (fig. 6A, step 606).

Regarding claims 5 and 12, Bohannon further discloses that the computer system comprises an update module to include additional identifiers (col. 3, lines 48-53; col. 14, line 65 – col. 15, line 1).

Regarding claims 6 and 13, Bohannon further discloses that a computer serial number is stored in the computer system (col. 8, lines 37-47).

Regarding claims 7 and 14, Bohannon does not explicitly disclose storing the computer serial number in the non-volatile memory; however, Examiner takes Official Notice that storing a computer serial number in a non-volatile memory is well known in the art. It would have been obvious at the time of the invention was made to store the computer serial number in a non-volatile memory since Examiner takes Official Notice that storing a computer serial number in a non-volatile memory to prevent loss of information when the power is removed from the computer is well known in the art.

Regarding claim 15, Bohannon discloses a process for delivery of custom-ordered software products to a computer system having anticipated elements. The

process comprises the steps of: writing a set of software products onto a CD-ROM, said set of software products containing at least one custom-ordered software product and other software products (Abstract); assigning a unique identifier to each software product in the CD-ROM (fig. 3); writing only the identifiers of said custom-ordered software products to the hard drive of the computer system (fig. 1; fig. 5, element 502; col. 14, line 65 – col. 15, line 4); inserting the CD-ROM into the computer system (fig. 1; elements 110, 126); reading the identifiers stored in the hard drive (col. 8, lines 57-63); comparing the retrieved identifiers with said identifiers of the software products stored in the CD-ROM (col. 8, lines 57-63); installing the custom-ordered software products having identifiers that match the identifiers in the hard drive but not installing the other software products (fig. 6B). Bohannon does not disclose using a non-volatile memory to store the identifiers. Mullor discloses using a non-volatile memory to store data regarding software usage authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bohannon system to use a non-volatile memory to store the identifiers, which are software usage authorization data, as taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile memory (col. 3, lines 4-9).

Regarding claim 16, Bohannon further discloses that set of software products is written onto the CD-ROM before the custom-ordered software products is ordered (Abstract).

Regarding claim 17, Bohannon does not teach testing the set of software products before it is written onto the digital storage device. However, Examiner takes

Official Notice that testing software products for correctness prior to distribution is well known in the art. It would have been obvious at the time of the invention was made to test the set of software products before it is written onto the CD-ROM for distribution since Examiner takes Official Notice that testing software products for correctness prior to distribution is well known in the art.

Regarding claim 18, Bohannon further discloses that the identifier is encrypted (fig. 6A, step 606).

Regarding claim 24, Bohannon discloses a method for installing software products comprising: copying identifiers of software products to be installed from a floppy disk to a hard drive of a computer system (fig. 1; fig. 5, element 502); comparing identifiers stored in the hard drive with identifiers of a plurality of software products stored in a CD-ROM (fig. 1; fig.3; col. 8, lines 56-63); installing each software product in the computer system only if its identifier matches one identifier stored in the hard drive (Abstract; fig. 6B); after said installing each software product, adding one or more identifiers into the hard drive to install new software products (col. 3, lines 48-53). Bohannon does not disclose using memory to store the identifiers. Mullor discloses using a non-volatile memory to store data regarding software usage authorization (col. 1, lines 48-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Bohannon method to use a non-volatile memory to store the identifiers, which are software usage authorization data, as taught by Mullor. It would be more difficult to tamper with data stored in a non-volatile memory (col. 3, lines 4-9).

4. Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohannon in view of Mullor as applied to claims 15 and 24 above, and further in view of Colvin (6,857,078).

Regarding claim 19, Bohannon and Mullor do not teach checking a serial number of the computer system before the identifiers are written to the non-volatile memory. Colvin discloses a method for securing software including the step of checking a serial number of a computer system before information required for installation of a software product is provided to the computer system (col. 4, line 63 – col. 5, line 43; col. 7, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Bohannon and Mullor to include the step of checking a serial number of a computer system before information required for installation of a software product is provided to the computer system, as taught by Colvin. The motivation for doing so would have been to monitor compliance with licensing terms. Accordingly, the step of checking is done before the identifiers are written to the non-volatile memory.

Regarding claim 25, Bohannon and Mullor do not teach comparing a serial number of the computer system with a serial number provided by a user before the identifiers are written to the non-volatile memory. Colvin discloses a method for securing software including the step of comparing a serial number of the computer system with a serial number provided by a user before information required for installation of a software product is provided to the computer system (col. 4, line 63 –

col. 5, line 43; col. 7, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Bohannon and Mullor to include the step of comparing a serial number of the computer system with a serial number provided by a user before information required for installation of a software product is provided to the computer system, as taught by Colvin. The motivation for doing so would have been to monitor compliance with licensing terms. Accordingly, the comparing is done before the one or more identifiers are added to the memory.

5. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al (6,016,400) in view of Bohannon.

Regarding claim 20, Day discloses a system comprising a processor; a floppy disk drive that reads data from a floppy disk, the floppy disk configured to contain a plurality of software identifiers before a consumer receives the system; wherein the system is adapted to receive a CD-ROM containing software products, each software product having an associated software identifiers that is unique to each software product; and wherein the processor is adapted to install only software products from the CD-ROM that have software identifiers that match software identifiers store in the floppy disk (Abstract; fig. 1; col. 3, line 65 – col. 4, line 30). Day does not disclose storing the plurality of software identifiers in the system storage. Bohannon discloses that a configuration file containing a plurality of software identifiers of software to be installed in a computer system is copied from a floppy disk to the hard disk of the computer

system for use by the CPU (figures 2, 5; col. 14, line 65 – col. 15, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Day system such that the plurality of software identifiers is copied from a floppy disk to the hard disk of the computer system for use by the CPU, as taught by Bohannon. The motivation for doing so would have been that data store in the hard disk could be accessed much more quickly.

Regarding claim 21, Day does not disclose comparing the software identifiers stored in the CD-ROM to the software identifiers stored in the hard disk. Bohannon discloses that the CPU compares the software identifiers stored in the CD-ROM to the software identifiers stored in the hard disk (col. 8, lines 57-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Day system further such that the processor compares the software identifiers stored in the CD-ROM to the software identifiers stored in the hard disk, as taught by Bohannon. The motivation for doing so would have been that a list of licensed software products could be displayed.

Regarding claims 22-23, Day does not disclose storing additional software identifiers in the hard disk to allow installation of new software products stored in the CD-ROM. Bohannon discloses that the CPU stores additional software identifiers in the hard disk to allow installation of new software products stored in the CD-ROM (col. 3, lines 47-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Day system further such that the processor stores additional software identifiers in the hard disk to allow installation of new software

products stored in the CD-ROM, as taught by Bohannon. The motivation for doing so would have been to allow installation of new software products.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,978,590 to Imai et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
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3/28/05

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